

REMARKS

Applicant encloses proposed amended Figures 1b and 1c to conform to the Examiner's objections.

The Examiner has rejected Claims 1 – 5, 8, 9, 11 – 19, 21, 22 and 24 under 35 U.S.C. §112, first paragraph asserting that the above noted claims contain “new matter.” Specifically, the Examiner objects to the use of the expression “conjugated polymer system” saying the limitation has no support in the specification, and applicants failed to provide any support for it.

Applicant directs the Examiner's attention to page 1 of the specification, at the eleventh and sixth lines from the bottom which state: “*Herein we describe electrically conducting polymers and precursors thereof, for example substituted and unsubstitutedThese polymers are conjugated systems which are made electrically conducting by doping.*” This is the basis for the inclusion of the element into the claims.

The Examiner contends that method claims found in Claims 6, 7, 10 and 20 are incomplete and indefinite since it is unclear what is obtained by the method recited. Whether it is a solution or a solid.

Applicant respectfully submits that there is no requirement that the claims include the final article which is formed from the composition made by the method claimed. The statute requires “utility.” The utility of the product formed from the composition made using the process of the present invention has been set forth in the specification, and specifically in Claim 17. Applicant has complied with the patent statute and need not include whether the final product is a solution or a solid. The product formed can be put to a number of uses which need not be specified in each claim.

The Examiner is requested to reconsider the rejection under 35 U.S.C. §102(b) of Claims 1, 3 – 7, 13 – 18 as anticipated or in the alternative, under 35 U.S.C. §103(a) as obvious over EP 0315514 ('514). The '514 reference does disclose a polyaniline but the similarity between the reference and the present invention ends there. The Examiner is rejection the claim as

anticipated based upon an unwarranted assumption. There is no proper foundation to assert that because certain constituents of Applicant's invention are disclosed in the prior art, that the invention is anticipated. The rejection is not based upon a proper teaching found in a reference disclosure, but rather on the assertion that "*the acid doped polyaniline inherently meets the formula of claim 14 and undoped polyaniline inherently meets the formula of claim 15.*" The properties and other information necessary to form a valid rejection to the claims is not explicitly set forth in the '514 reference.

It is further improper to reject Claims 1 – 7, 9, 10, 13 – 18 as obvious because the reference discloses a concentration. It is hindsight to contend that the skilled artisan would adjust the concentration based upon reviewing a reference wherein the major objective not analogous to Applicant's objective.

Applicants respectfully submit that the specificity of the Kim, et al. Rosato reference and Kumar references do not rise to the level required to qualify as an appropriate reference with respect to Applicant's invention.

Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.
(Citations omitted) In re Lonnie T. Spada et al., 911 F.2d 705, 708 (Fed. Cir. 1990)

The Examiner is requested to reconsider his rejection of Claims 1 – 4, 6, 7, 10 – 12, 16 – 19 and 22 – 24 pursuant to 35 U.S.C. §102(b) and §103(a) using the reference to Ikenaga, et al. (U.S. Patent 4,772,421).

Ikenaga, et al. disclose a process for manufacturing an electroconductive resin composite by polymerizing at least one monomer, a polymer of which is electroconductive in a matrix of a resin which results in the anisotropy in the melt phase to form a composite of the obtained polymer and the resin and a resin composite as obtained by the process. Ikenaga, et al. do not disclose anything that could be construed to anticipate or render obvious the present invention. The monomers used are acetylenes, vinyl compounds, aromatic compounds, etc.

Ikenaga, et al. do not teach the polymerization as claimed by Applicant. Further, the uses to which the final products are put are totally different.

Ikenaga, et al. states that the electroconductive material obtained according to their invention is used as a material for solar batteries in the form of a sheet having a large area and high efficiency. Other allied use is one of a variety of sensors. This use, which must be considered from the perspective of obviousness, is totally outside the scope of Applicant's products.

Ikenaga, et al. discloses three "resins" in the Examples section of the patent. The resins are formed from 4-acetoxybenzoic acid, 6-acetoxy-2-naphthoic acid at various levels and 2,6-dicetoxynaphthalene (*sic*) and terephthalic acid.

The Examiner has referred to Examples 6 – 12 in Ikenaga, et al. to support the rejection. Example 6 discloses taking 10 parts of resin and 0.001 mol of catalyst and forming a film therefrom. The resulting film was cured with 5 ml of pyrrole in a solvent mixture of pentafluorophenol and hexafluoroisopropanol. This disclosure does not serve to anticipate or render obvious the present invention. The "cured" procedure is important as it distinguishes the essence of the present invention from Ikenaga, et al. "Curing" is a process that changes the physical properties of a material by chemical reaction which may be condensation, polymerization, or vulcanization; usually accomplished by the action of heat and catalysts, alone or in combination, with or without pressure.

It is clear that the Ikenaga, et al. method and ultimate formed product are totally different from the Applicant's invention as claimed. The final assembled product of Ikenaga, et al. does not have the same physical characteristics as Applicant's product as claimed. The fluorine containing polymer is not used for the same purpose as Applicant, and there is no disclosure in Ikenaga, et al. that the fluorine solvent remains in the final cured product.

The Examiner is requested to reconsider his rejection of Claims 1 – 4, 6, 7, 9 – 19 and 22 – 24 pursuant to §103(a) as obvious over Ikenaga, et al. (U.S. Patent 4,772,421) in view of Tan (U.S. Patent 5,863,658) or EP 0315514 (EP).

The basis for the above-cited rejection according to the Examiner is the contention that Tan and EP disclose polyaniline and Ikenaga, et al. disclose adjusting the solvent and the fact that they employ various polymers and precursors. There is nothing in the two polyaniline disclosing references that would warrant combining their teachings with Ikenaga, et al. who does not mention polyaniline, *per se*.

The Tan reference discloses a composition of polyaniline and an aromatic benzobisthiazole, benzobisoxazole, or benzobisimideazole. This a straightforward blend of polymers. Tan does make reference in the description of the prior art that it has been discovered that the use of organic sulfonic acids as protonic dopants can result in conductivity of the form of polyaniline mentioned. This disclosure is certainly not anticipatory of Applicant's invention.

In order to analyze the propriety of the Examiner's obviousness rejections in this case with respect to the three references cited, a review of the pertinent applicable law relating to 35 U.S.C. § 103 is warranted. The Examiner has applied the Tan, EP and Ikenaga, et al. references using selective combinations to render obvious the invention. There is only general reference to the locations in the references where they disclose alleged relevant material. There is no specific rationale as to why the references are combinable.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the

claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

Applicants respectfully submit that there is no basis for the combination of the Tan, EP and Ikenaga, et al. references cited by the Examiner. The Examiner has selected polymers or physical characteristic specifications from these disparate references for the sake of showing the individual elements claimed without regard to the total teaching of the references. As noted, the Examiner is improperly picking and choosing. It is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case because she did in fact pick and choose so much of the Tan, EP and Ikenaga, et al. references to support his position and did not cover completely in the Office Action the full scope of what these varied disclosure references fairly suggest to one skilled in the art.

There is no proper basis for combining the totally different disciplines of the Tan, EP and Ikenaga, et al. references as has been done in the Official Action.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness, and that this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The Court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so.

In the present case, the skilled artisan viewing the any or all of the references would be directed toward a totally different system than is called for in the present invention.

The Examiner is requested to reconsider his rejection of Claims 1 – 4, 9 11 – 15 and 17 - 19 and 22 – 24 pursuant to §103(a) as obvious over Tan (U.S. Patent 5,863,658).

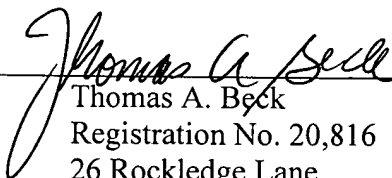
The Examiner states that Tan teaches a solution, and therefore the skilled artisan would know enough to adjust the concentration of polyaniline in a solvent. Tan may disclose a solvent, but it is not a fluorine-containing solvent. Looking only at the Tan disclosure, there is no basis for the skilled artisan to perceive the present invention as obvious.

Applicant has attempted to distinguish the invention as embodied in the amended claims over the prior art and the cited paragraphs of 35 U.S.C. § 112. The references cited clearly do not anticipate or render obvious the many dependent claims found in the application with the species defined therein. In view of the arguments and modifications to the claims, allowance of this case is warranted. Such favorable action is respectfully solicited.

Applicant requests and extension of time of two (2) months within which to respond to the August 19, 2004 Official Action. A check in the amount of \$430.00 is enclosed. Any fees which result from the claims added herein should be charged to Deposit Account 50-0510

In view of the arguments and modification to the claims, allowance of Claims 1 - 25 in this case is warranted. Such favorable action is respectfully solicited.

Respectfully Submitted,


Thomas A. Beck
Registration No. 20,816
26 Rockledge Lane
New Milford, CT 06776
Telephone (860) 354-0892

I certify that this amendment is being deposited with the United States Postal Service on the date shown below addressed to Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Thomas A. Beck January 18, 2005